

**REMARKS/ARGUMENTS**

Claim 1 has been amended to recite that the ink-receiving layer consists of at least one hydrophilic polymer, at least one cross-linking agent, at least one mordant, inorganic particles, at least one nonionic siloxane copolymer surfactant, and at least one nonsiloxane surfactant. Claim 1 has also been amended to recite that the hydrophilic polymer is selected from the group consisting of polyvinyl alcohol, a copolymer of polyvinylalcohol with polyethyleneoxide, a copolymer of polyvinylalcohol with polyacrylic or maleic acid, acetoacetylated polyvinylalcohol, polyethylene oxide, hydroxyethyl cellulose, hydroxypropylmethyl cellulose, poly(N-ethyl-2-oxazoline), casein, starch, agar, carrageenan, cellulose, carboxymethyl cellulose, dextran, pullulan, gelatin, derivatives thereof, and mixtures thereof. Support for the amendments is found in the as-filed specification at at least paragraphs [0011]-[0013], [0015]-[0022], and [0030]-[0035] (including Tables 1 and 2). Claims 2-9 have been amended to clarify the scope of the claims or to improve antecedent basis. No new matter has been added.

The Office Action mailed April 12, 2005, has been received and reviewed. Claims 1-20 are currently pending in the application. Applicant affirms the election to prosecute the invention of Group 1, claims 1-10. Claims 11-20 are withdrawn from consideration as being drawn to a nonelected invention and have been canceled without prejudice or disclaimer to the filing of one or more divisional applications on the subject matter thereof. Claims 1-10 stand rejected. Applicant has amended claims 1-9 and respectfully requests reconsideration of the application as amended herein.

**Double Patenting Rejection Based on U.S. Patent Application Publication No. 2005/0003113 A1**

Claims 1-5, 7, 9, and 10 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent Application Publication No. 2005/0003113 A1. In order to avoid further expenses and time delay, Applicant elects to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejection in compliance with 37 CFR §§ 1.321 (b) and (c). Applicant's filing of the terminal disclaimer should not be construed as acquiescence to the

Examiner's double patenting or obviousness-type double patenting rejection. Attached are the terminal disclaimer and accompanying fee.

### **35 U.S.C. § 102(b) Anticipation Rejections**

#### Anticipation Rejection Based on U.S. Patent No. 6,183,844 to Li

Claims 1-5, 7, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,183,844 to Li ("Li"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Li discloses an inkjet printing medium having a substrate and at least two water-absorptive coatings. Li at Abstract. Each of the water-absorptive coatings includes a matrix of a water-soluble, hydrophilic organic polymer and discrete nonfilm-forming particles. *Id.* at column 1, lines 21-39. The water-soluble, hydrophilic organic polymer includes a nitrogen-containing substance. *Id.* at column 5, lines 50-53.

Li does not anticipate claim 1 because Li does not expressly or inherently describe each and every element of the claim. Specifically, Li does not expressly or inherently describe that the ink-receiving layer "consist[s] of at least one hydrophilic polymer, at least one cross-linking agent, at least one mordant, inorganic particles, at least one nonionic siloxane copolymer surfactant, and at least one nonsiloxane surfactant." (emphasis added) Rather, Li discloses that its water-absorptive coatings include a water-soluble, hydrophilic organic polymer, discrete nonfilm-forming particles, and a nitrogen-containing substance. However, claim 1 recites the transitional phrase "consisting of" and, therefore, ingredients not specified in claim 1 are excluded. Since Li discloses that its water-absorptive coatings include, *inter alia*, a nitrogen-containing substance, Li does not expressly or inherently describe that its water-absorptive coatings *consists of* the recited ingredients. As such, claim 1 is not anticipated by Li.

Claim 2-5, 7, 9, and 10 are allowable, *inter alia*, as depending from an allowable base claim.

### 35 U.S.C. § 103(a) Obviousness Rejections

#### Obviousness Rejection Based on Li

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Li, as applied to claims 1-5, 7, 9, and 10 above. Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for an obviousness rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The obviousness rejection of dependent claims 6 and 8 is improper because the cited reference does not teach or suggest all of the claim limitations and does not provide a motivation to produce the claimed invention.

The teachings of Li are as described above.

Claims 6 and 8 depend on claim 1 and, therefore, include all of the limitations of claim 1. Li does not teach or suggest the limitation that the ink-receiving layer "consist[s] of at least one hydrophilic polymer, at least one cross-linking agent, at least one mordant, inorganic particles, at least one nonionic siloxane copolymer surfactant, and at least one nonsiloxane surfactant," as recited in claim 1, for substantially the same reasons as discussed above in the anticipation rejection. Since Li does not teach or suggest this limitation of claim 1, Li necessarily does not teach or suggest all of the limitations of claims 6 and 8.

Li also does not provide a motivation to produce the claimed invention. The Examiner states that "[o]ne of ordinary skill in the art would have been motivated to adjust the amount of

the combination of surfactants in order to optimize the surface tension of the layer.” Office Action of April 12, 2005, p. 5. However, even assuming *arguendo* that the Examiner’s proposed motivation is true, the claimed invention would still not be produced because the above-mentioned limitation would not be taught or suggested.

Since the cited reference does not teach or suggest all of the claim limitations and does not provide a motivation to produce the claimed invention, the obviousness rejection of claims 6 and 8 is improper and should be withdrawn.

#### ENTRY OF AMENDMENTS

The amendments to claims 1-9 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add new matter to the application.

#### CONCLUSION

Claims 1-10 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant’s undersigned attorney.

Respectfully submitted,



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Date: July 12, 2005  
ERC/KAH/ps:jm  
Document in ProLaw